

REMARKS

Claims 1- 51 are pending. Claim 1, 10, 21, 27, 32, 36, 42 and 47 have been amended, and no claims have been newly added. Reconsideration is respectfully requested.

PRIORITY DOCUMENT

Applicant notes that the Examiner indicated that a certified copy of the priority document had not been received as of the mailing date of this office action. Applicant submitted the priority document in January 2003 and would request that the Examiner indicate that he has received the certified copy of the priority document.

PRIOR ART REJECTIONS

In response to the Examiner rejection of Claims 1-7, 10- 44 and 47- 50 under 35 USC 103 as being unpatentable over U.S. Patent No. 5,925,127 to Ahmad (hereinafter "Ahmad") in view of U.S. Patent No. 5,953,005 to Liu (hereinafter "Liu") and Claims 8-9 and 45-6 under 35 USC 103 as being unpatentable over Ahmad in view of U.S. Patent No. 6,327,579 to Crawford (hereinafter "Crawford"), Applicant respectfully traverses the rejections. In particular, the prior art cited by the Examiner does not render the current claims of the patent obvious for the reasons set forth below. Therefore, early allowance of the claims is respectfully requested.

Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47

The Examiner has asserted that the combination of Ahmad and Liu renders the independent claims (Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47) unpatentable under 35 USC 103. To establish a obviousness prior art rejection based on a combination of prior art, the Examiner must establish 1) the relevant teachings of the prior art relied on; 2) the difference(s) in the claim over the applied reference(s); 3) the proposed modification of the applied reference necessary to arrive at the claimed subject matter; and 4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See MPEP 706.02(j). Furthermore, to establish a prima facie case of obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation to combine the references; 2) there must be reasonable expectation of success; and 3) the prior art must teach all the claim limitations. See MPEP 706.02(j). The Examiner has not established a prima facie case of obviousness for the reasons set forth below. In particular, the Examiner has not established 1) that the prior art teaches all of the claim limitations; and 2) the motivation to combine the references and the reasonable expectation of

success. Furthermore, Ahmad (which is relied on by the Examiner) teaches away from the invention. For these reasons, the rejections should be withdrawn.

Claim Limitations Are Not Taught

All of the independent claims in this application (Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47) recite, in relevant part, that the claimed optional files are called by the main executable file and executed by the main executable file to implement the rental software program and permit execution of the rental software program. Thus, the claimed rental software program includes the main executable file and the optional files wherein the optional files are part of the rental software program and are called by the main executable file. The optional files may include DLL files and registry files (See page 15, lines 11-14 of the application.) The spilt of the main executable file and the optional files means that the rental software program may start its execution and then, as an optional file such as a particular DLL is required, download the optional file and continue the execution of the rental software program.

Ahmad does not disclose this claimed feature. Ahmad specifically teaches that that an entire software program (a software module, such as applications programs, operating system modules, Internet browsers, etc..) are downloaded to a client computer, such as Microsoft Word in a preferred embodiment. See Col. 5, lines 19 – 27. In fact, a program module 100 and the corresponding CICO module 120 (that controls the use of the program module) are downloaded to the client. See Col. 9, lines 45 – 57. Thus, in Ahmad it is clear that only an entire software module is downloaded to the client computer so that it may be executed. Ahmad also does download the CICO module, but that module is downloaded with the program module and is not part of the program module. Thus, Ahmad does not disclose or suggest the claimed optional files.

Furthermore, Liu does not disclose or suggest these claimed optional files. In Liu, an applet (a software program) is delivered to the user which may include components such as graphics, video and audio. See Col. 4, lines 34 – 41. Liu then provides that, after the initial applet is delivered, multimedia content is delivered upon request as shown in Figure 4. Thus, after a song selection, the applet calls back to the database to request audio, video, timing and lyric information which are delivered to the user's computer where it is assembled and played. See Col. 4, line 63 – Col. 5, line 8.

If the Examiner asserts that the applet corresponds to the claimed rental software program, then the applet is downloaded at one time (not as a main executable file and optional files as claimed). The multimedia content is content being executed by the applet, but is not part of the applet as are the claimed optional files. The multimedia content is also not part of the rental software program wherein the execution of the rental software program occurs based on the optional

files. The applet in Liu would execute properly without any multimedia content so that multimedia content is not analogous to the claimed optional files.

In addition, if the Examiner asserts that the multimedia content is considered to be the claimed rental software program (and the applet is a control program), then each piece of multimedia content is also downloaded at one time (not as a main executable file and optional files as claimed) and therefore cannot be the claimed rental software program containing the optional files.

Thus, Ahmad and Liu, in combination, do not teach each element of the claimed invention as recited in the independent claims.

No Motivation and Reasonable Expectation of Success Set Forth

In addition to the lack of teaching of each element of the claimed invention, the rejection presented by the Examiner does not set forth a suggestion/motivation to combine Ahmad and Liu. For example, in Claim 1, the Examiner asserts that "It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the multiple files download feature of Liu with Ahmad's system to provide a more flexible and attractive software rental distribution system allowing users to request, download and pay for only the specific software modules they actually want to use" (Office action, page 2.) However, the Examiner does not set forth the motivation to combine/suggestion to combine Liu and Ahmad. The Examiner does point out the benefit of such as a combination, but does not explain why one might combine these patents or that the combination has a reasonable expectation of success. At most, the Examiner states the conclusion that it might be desirable, but does not point to any suggestion in either reference to combine it with the other reference. A prima facie obviousness rejection requires a showing of that motivation which does not exist in Ahmad or Liu. It is also not possible to explain that a motivation for the combination since Ahmad and Liu are directed to very different technologies.

Furthermore, Ahmad teaches away from the claimed invention. Ahmad teaches that the rental software download is done as a single file as set forth above. Thus, Ahmad teaches away from the claimed invention and teaches that one of ordinary skill in the art of rental software programs would download the entire rental software program (and not the main executable file separate from the optional files as claimed.) Therefore, the obviousness rejection of the independent claims should be withdrawn since 1) the prior art does not teach each element of the claimed invention; and 2) the motivation to combine the prior art is not set forth in the rejection.

Claims 2, 28, 37 and 48

These claims (2, 28, 37 and 48) are allowable over the prior art for at least the same reasons as the independent claims. Furthermore, these claims recite, in relevant part, a process manager means further comprising means for creating and running a process corresponding to the main executable file, means for suspending the process if the process requests one or more optional files,

and means for re-starting the process if said process manager means receives the one or more optional files from said server computer system. Ahmad does not describe this feature. The portion of Ahmad cited to by the Examiner describes the CICO module that controls the execution of the program module in Ahmad. However, the CICO module does not 1) create and run a process corresponding to the main executable file, 2) suspend the process if the process requests one or more optional files, and 3) re-starts the process if said process manager means receives the one or more optional files from said server computer system. Nowhere does Ahmad describe this feature in which the execution of the claimed rental software program is started, suspended and then restarted when an optional file is received from the server. In Ahmad, the program module is continuously executed. Therefore, the prior art does not disclose/suggest the claimed feature and allowable of these claims is respectfully requested.

Claims 7, 35, 41 and 44

These claims (7, 35, 41 and 44) are allowable over the prior art for at least the same reasons as the independent claims. Furthermore, these claims recite, in relevant part, a program database for storing path information of the main executable file, a list of rental software programs and a list of the optional files and an analyzing means for analyzing a new rental software program when the new rental software program is installed in said server computer system, wherein said analyzing means further comprises means for storing the path information of the main executable file and a list of the optional files, associated with the new rental software program, in said program database. Ahmad and Liu does not describe this feature. The portion of Ahmad cited by the Examiner (Col. 9, lines 16- 37) describes that a software registry is maintained on the server. In Ahmad, each program module is registered. As set forth in the claim, the path information for each main executable file as well as each optional file is stored since the claimed invention must link the main executable file and the optional files together so that main executable file and then later the optional files for a particular rental software program may be located and downloaded to the user. Ahmad downloads a single program module to the user and therefore cannot perform the analyzing and storing steps set forth in the claim. Furthermore, Liu does not disclose the analyzing and storing processes described. Therefore, Claims 7, 35, 41 and 44 are allowable over the prior art cited by the Examiner.

Change of Address

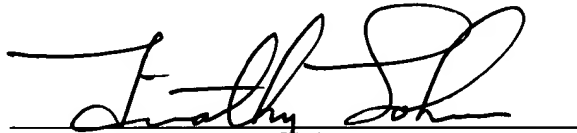
Please note that the attorneys of record have moved to a new office. Please direct all future correspondence for this application to:

Timothy W. Lohse
Gray Cary Ware & Freidenrich L.L.P.
1755 Embarcadero Road
Palo Alto, CA 94303-3340
Main Line: (650) 833-2000
Direct Line: (650) 320-7426

Customer Number: 26379

For the foregoing reasons, it is respectfully submitted that the claims are in an allowable form, and action to that end is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy W. Lohse', is written over a horizontal line.

Timothy W. Lohse
Reg. No.35,255
Attorney for Applicants

Dated: May 6, 2003

GRAY CARY WARE & FREIDENRICH LLP
1755 Embarcadero Road
Palo Alto, CA 94303
Telephone: (650) 320-7426